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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,826	03/15/2004	Seok-jun Won	5649-837DV	1388

20792 7590 07/10/2006

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EXAMINER

GRAYBILL, DAVID E

ART UNIT PAPER NUMBER

2822

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/800,826	<b>Applicant(s)</b> WON ET AL.	
	<b>Examiner</b> David E. Graybill	<b>Art Unit</b> 2822	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 43-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1 MAR 2006</u> | 6) <input type="checkbox"/> Other: _____  |

Applicant's election without traverse of Group IV, drawn to claims 43-50, in the reply filed on 4-3-6 is acknowledged.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 23-25 of U.S.

Patent No. 6,750,092. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 23-25 of the patent are generic to the species of invention covered by claims 43-46, 38 and 50 of the application. Thus, the generic invention is "anticipated" by the

species of the patented/application invention. See *In re Goodman* (CAFC) 29 USPQ2d 2010, and MPEP 806.04(i).

Further, the omission of the patent claim limitations in the instant claims is obvious because omission of an element and its function is obvious if the function of the element is not desired. See *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989); *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975); and MPEP 2144.04IIA.

Also, although claims 43-46, 48 and 50 recite limitations not recited in claims 23-25 of 6,750,092, these limitations are inherent in the process of the patent.

Also, although claims 47 and 49 recite limitations not recited in claims 23-25 of 6,750,092, the patent claims disclose that the first and second gas flow rates are result effective variables, and that the second oxygen gas flow rate is less than the first oxygen gas flow rate. Moreover, as reasoned from well established legal precedent, it would have been an obvious matter of design choice bounded by well known manufacturing constraints and ascertainable by routine experimentation and optimization to choose the particular claimed flow rate limitations because applicant has not disclosed that, in view of the applied prior art, the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical,

and it appears prima facie that the process would possess utility using another flow rate. Indeed, it has been held that optimization of range limitations are prima facie obvious absent a disclosure that the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical. See MPEP 2144.05(II): "Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. '[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.'" In re Aller, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955). See also In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969), Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989), and In re Kulling, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990). As set forth in MPEP 2144.05(III), "Applicant can rebut a prima facie case of obviousness based on overlapping ranges by showing the criticality of the claimed range. 'The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range.' In

re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP § 716.02 - § 716.02(g) for a discussion of criticality and unexpected results."

In the rejections *infra*, generally, reference labels are recited only for the first recitation of identical claim elements.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 43-45 and 48 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Okudaira (6078073).

At column 4, line 46 to column 5, line 17; column 5, line 49 to column 6, line 26; column 6, lines 42-65; column 13, line 62 to column 16, line 39, Okudaira discloses a method of forming an integrated circuit device, comprising: forming a lower electrode 1 on a substrate 11; forming a dielectric layer 7 on the lower electrode; and forming an upper electrode 9 on the dielectric layer; wherein at least one of the lower electrode and the upper electrode comprises a ruthenium film having a stratified oxygen concentration; wherein the oxygen concentration profile substantially

approximates a step function; wherein the oxygen concentration profile of the upper electrode is relatively high from a surface of an underlayer "first metal layer" to a predetermined thickness (to the intersection of "first metal layer" and "second metal layer"), the oxygen concentration profile rapidly (instantaneously) decreases (to zero) at the predetermined thickness, and the oxygen concentration profile is relatively low (zero) and substantially constant from the predetermined thickness toward a top surface of the ruthenium film, and wherein forming the upper electrode comprises: inherently reacting a ruthenium source gas (ejected from sputter target) and oxygen to deposit ruthenium on the substrate; and changing at least one of a pressure, an oxygen gas flow rate (to zero), and a substrate temperature during the step of reacting the ruthenium source gas and oxygen.

The art made of record and not applied to the rejection is considered pertinent to applicant's disclosure. It is cited primarily to show inventions relevant to the examination of the instant invention.

**For information on the status of this application applicant should check PAIR:**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Alternatively, applicant may contact the File Information Unit at (703) 308-2733. Telephone status inquiries should not be directed to the examiner. See MPEP 1730VIC, MPEP 203.08 and MPEP 102.**

Application/Control Number: 10/800,826

Page 7

Art Unit: 2822

Any other telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (571) 272-1930. Regular office hours:

Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is (571) 273-8300.

A handwritten signature in black ink, appearing to read 'David E. Graybill', is positioned above the printed name.

David E. Graybill  
Primary Examiner  
Art Unit 2822

D.G.

1-Jun-06